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10/632,479	08/01/2003	Yuri Leontiev	INTU-990057	3014

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PVF -- INTUIT, INC.
c/o PARK, VAUGHAN & FLEMING LLP
2820 FIFTH STREET
DAVIS, CA 95618-7759

EXAMINER
MURDOUGH, JOSHUA A

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/632,479	LEONTIEV ET AL.
Office Action Summary	Examiner	Art Unit	
	JOSHUA MURDOUGH	3621	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *12 May 2008*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *38-47* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *38-47* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20080701

DETAILED ACTION

Acknowledgement

1.   Claims 38-47 are pending and have been examined.

Continued Examination Under 37 C.F.R. § 1.114

2.   A request for continued examination under 37 C.F.R. §1.114, including the fee set forth

in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R.

§1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn

pursuant to 37 C.F.R. §1.114. Applicant's submission filed on 11 April 2008 has been entered.

Election/Restrictions

3.   The Examiner notes Applicant's election of invention I on 29 March 2007. In the 11

April 2008 response, Applicant cancelled all of the claims pertaining to invention I and "elected"

invention II. This is known as shift and as noted in MPEP 819, is not generally allowed.

However, in the interest of furthering the prosecution of this application, the Examiner has

allowed it this one time.

Claim Rejections - 35 USC § 112 2ⁿᵈ Paragraph

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

5.   Claims 38-47 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

6.   Claims 38, 46, and 47 recite "identification information concerning the user, and license

verification information concerning the user." One of ordinary skill in the art, reading this in

light of the specification would not understand the distinction between "identification

information concerning the user," described in the specification as being "a unique identifier

provided by the software vendor with the user's copy of the software," (Paragraph [0023]) and

"verification information concerning the user" described in the specification as being "sections

of the license file, or other data that can be used to verify that the user is licensed to run the

software program." (Id.) Clearly the unique identifier provided by the vendor with the user's

copy of the software can be used to verify that the user is licensed to run the software program.

7.   Claim 42 recites the term "acceptably similar." As noted in the 21 August 2007 Office

Action, it is a relative term which renders the claim indefinite as it could not be determined by

one of ordinary skill in the art what the standard is for being "acceptably similar."

8.   Claim 46 recites "A computer program product... comprising: a processor." Under the

broadest reasonable interpretation, a "computer program product" generally refers to a medium

(CD-ROM, Floppy disk, etc.) containing program code. Therefore, one of ordinary skill in the

art would not understand how a processor is to be incorporated into the medium. The Examiner

suggests amending the preamble to recite "A computer system for...." Also it is suggested that

the computer readable medium be introduced prior to the code residing on it. The Examiner

suggests the following language "a computer readable medium containing instructions that, when

executed, cause the computer system to perform desired actions, wherein the instructions

comprise:" to give the most weight to the program code.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

10.   Claims 38-41, 46, and 47, as best understood, are rejected under 35 U.S.C. §103(a) as

being unpatentable over Rabin (US 6,697,948) in view of Tinney (Organize Your Finances in a

Weekend with Quicken® 2000).

11.   As to claim 38, Rabin shows:

   a.   A computer implemented client method for dynamically managing a user

          software license, the method comprising:

   b.   receiving an action from the user **213** to access a software program

          (software(SW)) (Figure 12, step 370);

   c.   responsive to receiving the action from the user, sending a request (call up) to a

          server (guardian center) to access the software program (Id.), the request

          including identification information concerning the user (fingerprint), and license

          verification information concerning the user (tag) (Figure 12, step 372);

   d.   receiving current software license information concerning the user from the server

          (Figure 12, step 374); and

     e.   storing (an update stores new information) received current software license information concerning the user (Figure 12, step 375).

12.   Rabin does not expressly show that the validation is performed on a per feature basis.

13.   However, Tinney shows a list of features available to the user depending on the license possessed (Pages 327-329). As the features the user is permitted to use depend on the license, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Rabin to verify the license when the user attempts to use a feature that they may or may not have a license for in order to limit the user to only the features they are licensed for and thus, have paid for.

14.   As to claim 39, Rabin further shows:

     f.   performing at least one step (Figure 12, step 376) from a group of steps comprising:

     g.   displaying a message to the user indicating that the user is not licensed to run the software program (Column 54, lines 14-17);

     h.   providing the user with an opportunity to purchase a license to run the software program (Column 59, lines 38-57);

     i.   allowing the user to run the software program without a license for a limited time only (Column 5, lines 36-53);

     j.   allowing the user to run the software program without a license a limited number of times only (Id.); and

     k.   terminating the software program, such that the user cannot run the software

           program (Column 54, lines 14-19).

15.   As to claim 40, Rabin further shows:

     the received current software license information concerning the user comprises modified

           license information concerning the user (the tag is modified in Figures 13A and

           13B, therefore, the next time the tag is sent it would be modified).

16.   As to claim 41, Rabin further shows:

     l.   the modified license information concerning the user comprises a user software

           license from a group of user software licenses comprising:

     m.   an activated user software license (installed, Figure 6);

     n.   a deactivated user software license (gc_disabled, Id.);

     o.   an extended user software license (continued, Id.);

     p.   a restricted user software license (policy, Columns 55-56, lines 57-10);

17.   As to claim 46, Rabin shows:

     q.   A computer program product for dynamically managing a user software license,

           the computer program product comprising:

     r.   a processor **201**;

     s.   a memory **202**;

t.   program code for receiving an action from the user **213** to access a software
        program (Figure 12, step 370);

u.   program code for, responsive to receiving the action from the user, sending a
        request (call up) to a server (guardian center) to access the software program
        (Id.), the request including identification information concerning the user, and
        license verification information concerning the user (tag) (Figure 12, step 372);

v.   program code for receiving current software license information concerning the
        user from the server (Figure 12, step 374);

w.   program code for storing (an update stores new information) received current
        software license information concerning the user (Figure 12, step 375); and

x.   a computer readable medium on which the program codes are stored **200**.

18.   Rabin does not expressly show that the validation is performed on a per feature basis.

19.   However, Tinney shows a list of features available to the user depending on the license

possessed (Pages 327-329). As the features the user is permitted to use depend on the license, it

would have been obvious to one of ordinary skill in the art at the time of the invention to have

modified the teachings of Rabin to verify the license when the user attempts to use a feature that

they may or may not have a license for in order to limit the user to only the features they are

licensed for and thus, have paid for.

20.   As to claim 47, Rabin shows:

y.   (New) A computer system for dynamically managing a user software license, the
        computer system comprising:

z. means for receiving an action from the user **213** to access a software program (software(SW)) (Figure 12, step 370);

aa. means for, responsive to receiving the action from the user, sending a request (call up) to a server (guardian center) to access the feature of the software program (Id.), the request including identification information concerning the user (fingerprint), and license verification information concerning the user (tag) (Figure 12, step 372);

bb. means for receiving current software license information concerning the user from the server (Figure 12, step 374); and

cc. means for storing received current software license information concerning the user (Figure 12, step 375).

21. Rabin does not expressly show that the validation is performed on a per feature basis.

22. However, Tinney shows a list of features available to the user depending on the license possessed (Pages 327-329). As the features the user is permitted to use depend on the license, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Rabin to verify the license when the user attempts to use a feature that they may or may not have a license for in order to limit the user to only the features they are licensed for and thus, have paid for.

23. Claims 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabin and Tinney as applied to claim 38 above, and further in view of another embodiment of Rabin.

24.   As to claims 42-44, the Rabin/Tiney combination teaches as disclosed above, but does
not expressly teach:

      dd.   creating a current hardware configuration identifier of the computer associated
            with the user; and

      ee.   comparing the received hardware configuration identifier to the current hardware
            configuration identifier.

25.   However, Rabin teaches, outside of the embodiment used above, the use of a hardware
identifier, specifically a processor identifier, compared with the stored value to enable, or prevent
the use of software (Columns 1-2, lines 57-2). Therefore, it would have been obvious to one of
ordinary skill in the art at the time of the invention to have further modified the teachings of the
first embodiment of Rabin to use a processor identifier in the authentication of the user device
because hardware identifiers are more difficult to alter.

26.   As to claim 45, Rabin further shows:

      ff.   performing at least one step (Figure 12, step 376) from a group of steps
            comprising:

      gg.   displaying a message to the user indicating that the user is not licensed to run the
            software program (Column 54, lines 14-17);

      hh.   providing the user with an opportunity to purchase a license to run the software
            program (Column 59, lines 38-57);

      ii.   allowing the user to run the software program without a license for a limited time
            only (Id.); and

jj.   allowing the user to run the software program without a license a limited number
        of times only (Column 54, lines 14-19).

Claim Interpretation

27.   Although Applicant(s) use "means for" in claim 47, it is the Examiner's position that the
"means for" phrase(s) do not invoke 35 U.S.C. 112 6th paragraph. If Applicant(s) concur, the
Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances
of "means for" from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6th
paragraph should not be invoked.

28.   Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6th paragraph, the Examiner
respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving
such express invocation of 35 U.S.C. 112 6th paragraph, the "means for" phrase(s) will be
interpreted as set forth in the *Supplemental Examination Guidelines for Determining the
Applicability of 35 USC 112 6¶*.

29.   Failure by Applicant(s) in their next response to also address the 35 U.S.C. 112 6th
paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue
entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. 112 6th paragraph.
Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. 112
6th paragraph applies to all examined claims currently pending.

Double Patenting

30.   Claims 42-46 of this application conflict with claims 1-3, 29-31, 43-45, and 55-63 of

Application No. 10/684955. 37 CFR 1.78(b) provides that when two or more applications filed

by the same applicant contain conflicting claims, elimination of such claims from all but one

application may be required in the absence of good and sufficient reason for their retention

during pendency in more than one application. Applicant is required to either cancel the

conflicting claims from all but one application or maintain a clear line of demarcation between

the applications. See MPEP § 822.

Response to Arguments

31.   Applicant's arguments with respect to claims 38-47 have been considered but are moot in

view of the new ground(s) of rejection.

Conclusion

32.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-

3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

33.   If attempts to reach the Examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

34.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621